

Appl. No. : 09/378,878
Filed : August 23, 1999

REMARKS

In response to the Office Action mailed March 16, 2004 (the "Office Action"), Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments. Claims 1-17, 19-22, 27-32, 36-37, 39-54, 56-57, 59-63, 66-74, 133-136, 138-146, 149-157, 159-174, 177-181, and 207-212 are currently pending, and Claims 18, 23-26, 33-35, 38, 55, 58, 64-65, 75-132, 137, 147-148, 158, 175-176, and 182-206 have been cancelled. In this paper, Applicant amends previously objected to claims in accordance with the Examiner's suggestions and amends previously rejected claims as discussed below. Accordingly, pending Claims 1-17, 19-22, 27-32, 36-37, 39-54, 56-57, 59-63, 66-74, 133-136, 138-146, 149-157, 159-174, 177-181, and 207-212 are presented for further examination.

Objected to Claims

In the Office Action, the Examiner objected to Claims 27-30, 37, 71, 138-146, 159-173 177 and 180 as being dependent upon a rejected base claim, but stated they would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Accordingly, Applicant has rewritten the objected to claims to include the limitations of the base claim and intervening claims, as appropriate. In view of these amendments, Applicant respectfully submits that Claims 27-30, 37, 71, 138-146, 159-173 177 and 180 are now in condition for allowance.

Claim Rejections Under 35 U.S.C. § 112 First Paragraph

The Examiner rejected Claim 1 under 35 U.S.C. § 112 first paragraph as not providing reasonable enablement for "a tangentially substantial direction". Applicant respectfully traverses this rejection, and respectfully submits that support for "a tangentially substantial direction" can be found in the Specification at least on page 11 lines 25-29 which state "As used herein, the term "tangential" denotes, in the plane of one or more of a disc's data-encoding surfaces, the direction inward or outward along a line drawn from the disc's physical center to its outer circumference." In view of the above, Applicant respectfully submits that the rejections of Claims 1 under 35 U.S.C. § 112, first paragraph, have been overcome and requests that this rejection be withdrawn.

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Claim Rejections Under 35 U.S.C. § 112 Second Paragraph

The Examiner rejected Claims 1 and 39 under 35 U.S.C. § 112 second paragraph as being indefinite.

Regarding Claim 1, the Examiner stated it is not understood what is meant by “a substantially tangential direction”. As stated above, Applicant respectfully traverses this rejection, and respectfully submits that support for “a tangentially substantial direction” can be found in the Specification at least on page 11 lines 25-29 which states “As used herein, the term “tangential” denotes, in the plane of one or more of a disc’s data-encoding surfaces, the direction inward or outward along a line drawn from the disc’s physical center to its outer circumference.”

Regarding Claim 39, the Examiner states the limitation “said physically non-identical analyte-specific signal elements” has no antecedent basis. Applicant has amended Claim 39 herein to address this rejection. In view of the above, Applicant respectfully submits that the rejections of Claims 1 and 39 under 35 U.S.C. § 112, second paragraph, have been overcome and requests that those rejections be withdrawn.

Claim Rejections Under 35 U.S.C. § 103(a)

A. The Examiner rejected Claims 1-4, 9-22, 31, 32, 36, 39-42, 47-54, 56, 57, 59-63, 66, 67, 74, 133, 149-151, 157, 158, 179, 181, and 207-211 under 35 U.S.C. § 103(a) as being unpatentable over Gordon (U.S. Patent No. 6,327,031) (“Gordon”) and Takase et al. (EP 0 417 305 A1) (“Takase”).

Claims 1 and 39

Applicant has amended Claims 1 and 39 herein, e.g.,:

Claim 1: A method of analyzing data acquired by reading an optical disc having at least one readable analyte-specific signal element, said method comprising:
identifying a pattern in said data that indicates a structural dimension of said at least one readable analyte-specific signal element measured in a substantially tangential direction and extending across at least two adjacent tracks on the disc, and
analyzing said pattern using the structural dimension of said at least one readable analyte-specific signal element.

Claim 39: A method of analyzing data generated by reading a trackable optical disc having a plurality of physically non-identical concurrently readable

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analyte-specific signal elements, said method comprising identifying patterns in said data that distinguish among said physically non-identical concurrently readable analyte-specific signal elements, wherein said identifying is performed in a manner that is dependent on absolute position of said pattern in said data, and wherein said the act of identifying is performed using a structural dimension of said physically non-identical concurrently readable analyte-specific signal elements measured in a substantially tangential direction.

(Additions shown in underline, emphasis added)

Based on a careful review of the cited art, neither Gordon nor Takase, singly or in combination, disclose, teach or suggest at least the limitations emphasized in amended Claims 1 and 39. Accordingly, Applicant respectfully submits that the rejections of Claims 1 and 39 under 35 U.S.C. § 107(a) have been overcome and requests withdrawal of those rejections.

Claims 2-4, 9-22, 31, 32, 36, 40-42, 47-54, 56, 57, 59-63, 66, 67, and 74

Claims 2-4, 9-22, 31, 32, 36, 40-42, 47-54, 56, 57, 59-63, 66, 67, and 74 depend either directly or indirectly from Claims 1 and 39, which have been amended herein as discussed above. Therefore, for at least the reason of their indicated dependency upon allowable claims, Applicant respectfully submits that Claims 2-4, 9-22, 31, 32, 36, 40-42, 47-54, 56, 57, 59-63, 66, 67, and 74 also define subject matter that is patentable over the art of record.

Claim 133

Claim 133 has been amended to include the limitations of previously objected to Claim 148. Therefore, Applicant submits that Claim 133 now defines subject matter that is patentable over the art of record.

Claims 149-151, 157, 158, 179, 181, and 207-211

Claims 149-151, 157, 158, 179, 181, and 207-211 depend either directly or indirectly from Claims 1 or 133, which have been amended herein as discussed above. Therefore, for at least the reason of their indicated dependency upon allowable claims, Applicant respectfully submits that Claims 149-151, 157, 158, 179, 181, and 207-211 also define subject matter that is patentable over the art of record.

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B. The Examiner rejected Claims 5-8 and 43-46 under 35 U.S.C. § 103(a) as being unpatentable over Gordon (U.S. Patent No. 6,327,031) ("Gordon") as modified by Takase et al. (EP 0 417 305 A1) ("Takase") and further in view of Oguro (U.S. Patent No. 6,344,939).

Claims 5-8 and 43-46 depend either directly or indirectly from Claims 1 and 39, which have been amended herein. Therefore, for at least the reason of their indicated dependency upon allowable claims, Applicant respectfully submits that Claims 5-8 and 43-46 also define subject matter that is patentable over the art of record.

C. The Examiner rejected Claims 68-70, 72, 73 and 178 under 35 U.S.C. § 103(a) as being unpatentable over Gordon (U.S. Patent No. 6,327,031) ("Gordon") as modified by Takase et al. (EP 0 417 305 A1) ("Takase") and further in view of Maruyama et al. (U.S. Patent No. 6,453,119 B1).

Claims 68-70, 72, 73 and 178 depend either directly or indirectly from Claims 39 or 133 which have been amended herein as discussed above. Therefore, for at least the reason of their indicated dependency upon allowable claims, Applicant respectfully submits that Claims 68-70, 72, 73 and 178 also define subject matter that is patentable over the art of record.

D. The Examiner rejected Claims 134-136 and 174 under 35 U.S.C. § 103(a) as being unpatentable over Gordon (U.S. Patent No. 6,327,031) ("Gordon") as modified by Takase et al. (EP 0 417 305 A1) ("Takase") and further in view of Ota et al. (U.S. Patent No. 5,920,529).

Claims 134-136 and 174 depend either directly or indirectly from Claim 133 which is amended herein to include all the limitations of previously objected to Claim 148, as discussed above. Therefore, for at least the reason of their indicated dependency upon allowable claims, Applicant respectfully submits that Claims 134-136 and 174 also define subject matter that is patentable over the art of record.

In view of the above, Applicant respectfully submits that Claims 1-17, 19-22, 27-32, 36-37, 39-54, 56-57, 59-63, 66-74, 133-136, 138-146, 149-157, 159-174, 177-181, and 207-212 are now in condition for immediate allowance and such prompt allowance of the same is respectfully requested.

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CONCLUSION

The Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes pursuant to statutory sections 112 and/or 103, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. In light of these amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language.

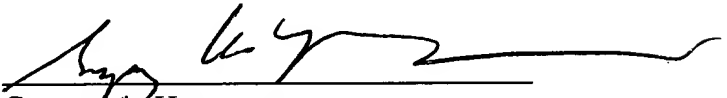
If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: June 16, 2004

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SUMMARY OF INTERVIEW

Exhibits and/or Demonstrations

Proposed amended claim set.

Identification of Claims Discussed

Claims 1 and 39

Identification of Prior Art Discussed

- (1) U.S. Patent No. 6,327,031 issued to Gordon ("Gordon")
- (2) European publication EP 0 417 305 of Takase et al. ("Takase")

Proposed Amendments

Proposed amendments were sent to the Examiner to facilitate the discussion

Principal Arguments and Other Matters

The cited prior art does not disclose, suggest or teach all the elements of Claims 1 or 39.

Results of Interview

The applicant wishes to thank the Examiner for the personal interview conducted on June 9, 2004. Although specific claim language for amending the rejected claims was not agreed to, the comments by Examiner and his Supervisor were helpful to determine the claim amendments made herein.